

### **Remarks**

Claims 1-49 are pending. Claims 1-49 have been rejected. Claims 1, 14, 15, 28, and 29 are hereby amended. Claims 47, 48, and 49 are hereby cancelled. Claims 50, 51, and 52 are hereby added. Applicants submit that the Examiner has misinterpreted the cited references in a number of aspects as they relate to the claimed invention. Applicants have not addressed these misinterpretations because it is believed the misinterpretations are moot in light of the amendments made. However, Applicants reserve the right to address these issues in the future if they become relevant to this prosecution.

### **Rejection of Claims Under 35 USC §102**

Claims 1 - 11, 14 are rejected under 35 U.S.C. §102(b) as being anticipated by Tsukazaki (US 5,589,667)

Applicants have amended claim 1 to recite that the tube is circumferentially continuous and that the primary lines of localized weakening are positioned on the tube. These amendments are supported by the specification at, e.g., p. 4, lines 5-8 and p. 5, lines 4-14 where it is explained that the tubes are extruded as unitary structures and the primary lines of localized weakness are positioned on the tube by ablation or other means. As stated in the specification at p. 4, lines 8-9, "No interlocking means are necessary for maintaining the tubular shape of the removable core." Applicants have also amended claims to remove the limitation that the tube is extruded.

Applicants submit that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 (citing *Verdegall Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Applicants submit that Tsukazaki does not describe every element of the claimed invention because the core of Tsukazaki is a hollow structure formed by bending a flat sheet of plastic material into a tube-like shape requiring interlocking means elements at the one longitudinal edge to interlock with their respective interlocking means counterparts at the other longitudinal edge as illustrated in Figure 2 of the reference. Figure 1 of Tsukazaki shows that the interlocking projections (15, 16) produce a joint (12) in the tube-like shape of the core (1). The

interlocked joint of Figure 8 (identified as a basis for rejection) requires engagement of female (34) and male (35) engagement sections to form a hollow core. Accordingly, Tsukazaki does not disclose a circumferentially continuous tube, which is an element of the amended claims.

Based on the foregoing, Applicant(s) submit that the cited reference cannot support a 35 U.S.C. 102 (b) rejection and respectfully requests that the rejection be withdrawn.

Claims 29 - 43, 46 have been rejected under 35 U.S.C. §102(b) as being anticipated by Tsukazaki

Claim 29 has been amended to recite that the removable core is circumferentially continuous and that the plurality of sections of a primary line of localized weakening are positioned on the tube. For the reasons given with regard to amended claim 1, the reference of Tsukazaki does not disclose a circumferentially continuous tube structure, but instead discloses the joining of opposing edges of a sheet having interlocking projections that hold the sheet in the approximate shape of a tube or cylinder. Accordingly, Tsukazaki does not describe every element of the claimed invention.

Based on the foregoing, Applicant(s) submit that the cited reference cannot support a 35 U.S.C. 102 (b) rejection and respectfully requests that the rejection be withdrawn.

### **Rejection of Claims Under 35 U.S.C. §103**

Claims 12, 13, 15 - 28, 44, 45, 47-49 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tsukazaki in view of Sadlo (US 5,925,427).

Claim 15 has been amended to clarify that the removable core comprises a circumferentially continuous tube and that the at least two primary lines of localized weakening are positioned on the tube.

Applicants submit that according to MPEP 2142, to establish a case of prima facie obviousness, three basic criteria must be met: 1) there must be some suggestion or motivation, either in the references or generally known to one skilled in the art, to modify or combine reference teachings, 2) there must be reasonable expectation of success, and 3) the prior art references must teach or suggest all the claim limitations. The ability to modify the method of the references is not sufficient. The reference(s) must provide a motivation or reason for making

the changes. *Ex parte Chicago Rawhide Manufacturing Co.*, 226 USPQ 438 (PTO Bd. App. 1984).

Applicants respectfully submit that the references cannot support a case of *prima facie* obviousness as to the amended claims because, among other possible reasons, the cited references do not provide a motivation or suggest for a circumferentially continuous tube because the formation of each of the cores of Tsukazaki and Sadlo rely on interlocking or coupling projections (*see e.g.*, Tsukazaki at col. 3, lines 1 - 11 and Sadlo at col. 3, lines 38 - 45). Furthermore, there could be no reasonable expectation of success because the process by which the cores of Tsukazaki and Sadlo are made would not work with a circumferentially continuous tube. In addition, the references do not disclose all the elements of the present invention because they do not disclose a circumferentially continuous tube.

For these reasons, Applicant(s) submit that the cited references will not support a 103(a) rejection of the claims invention and request that the rejection be withdrawn.

In addition to the foregoing arguments, Applicant(s) submit that a dependent claim should be considered allowable when its parent claim is allowed. *In re McCairn*, 1012 USPQ 411 (CCPA 1954). Accordingly, provided the independent claims are allowed, all claims depending therefrom should also be allowed.

Based on the foregoing reasons, it is submitted that the application is in condition for allowance. Withdrawal of the rejections under 35 U.S.C. 102 and 103 is requested. Request is respectfully made for reconsideration of the application and allowance of the claims.

Please charge Deposit Account 13-3723 any amounts due and owing by reason of this

response. For further questions, please contact Applicant's agent who may be reached at telephone number (512) 984-4308.

Respectfully submitted,

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Date

By: Melanie Gover  
Melanie G. Gover, Reg. No.: 41,793  
Telephone No.: (512) 984-4308

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833